

Applicant: Sawayama, et al.
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REMARKS

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the following remarks.

Claims 1-62 are pending in the subject application, of which claims 18-33 and 35-62 were withdrawn from consideration. Claims 1-17 and 34 stand rejected under 35 U.S.C. §103..

35 U.S.C. §103 REJECTIONS

Claims 1-17 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over the cited prior art for the reasons provided on pages 2-3 of the above-referenced Office Action. The following addresses the specific rejections provided in the above-referenced Office Action.

TAI ET AL.

Claims 1-17 and 34 stand rejected as being unpatentable over Tai et al. [USP 5,608,837; "Tai"] for the reasons provided on pages 2-3 of the above referenced Office Action. Applicants respectfully traverse.

As grounds for the rejection, the above-referenced Office Action appears to suggest, although not stated explicitly, that the cited reference discloses, teaches or suggest the invention as claimed except for an antireflection film on the front of the guide and therefore on the surface of the display and a diffuser. It should be noted that

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the two specific features identified, namely the antireflection film and the diffuser, are features of dependent claims and not found in the independent claim, claim 1. The Office Action further provides, without further substantiation that it is notoriously well known to put antireflection films on the outermost surface of a display to prevent reflection and that diffusers are notoriously well known for the function defined by the name. It thus is apparently concluded in the Office Action that because such is notoriously well known it would have been obvious to provide the antireflection film on the outermost surface of a display and to provide a diffuser. Applicants respectfully traverse.

Applicants claim, claim 1 a front illumination device that includes a light source and a light directing body that is placed in front of an object to be illuminated. The light directing body having an incidence surface on which light from the light source is made incident, a first light-releasing surface and a second light-releasing surface, where the first and second light-releasing surfaces are placed face-to-face. Light is released from the first light-releasing surface to the object to be illuminated and the light reflected from the object to be illuminated is released by the second light-releasing surface.

Also, the second light-releasing surface is formed into step shape in which slanting portions for reflecting light mainly from the light source toward the first light-releasing surface and flat portions for transmitting light reflected mainly from the object to be illuminated are alternatively placed.

As explained in the subject application and also in the cited reference, Tai, conventional liquid crystal displays are mainly classified into transmission type LCDs

and reflection type LCDs. As taught in Tai, conventional transmission type displays use backlighting systems (see column 1, lines 39-41 thereof). It also is clear from Tai, with particular reference to the Abstract thereof, that the type of display disclosed and taught in Tai is a transmission type display that uses a backlighting system.

It is respectfully submitted that a backlighting system such as that disclosed and taught in Tai has a completely different technical background from that of the present invention that relates to a front illuminating device. In the present circumstances, the Office Action merely asserts that the present invention is unpatentable over the cited reference. It does not provide any justification, rationale or basis as to why one skilled in the art would have used the teachings and disclosures of Tai for a transmission type display embodying a backlighting system, so as to yield the front illuminating device of claim 1. There also is no reasoning provided, assuming *arguendo* that such a modification was possible, as to why one skilled in the art would have been motivated or taught, absent the disclosures and teachings provided by Applicants, to modify the backlighting illuminating device disclosed and taught in Tai so as to yield the front illuminating device as set forth in claim 1.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, and as provided in MPEP 2143.02, a prior

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art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 19866). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Also, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As indicated above, no such teaching, suggestion or motivation has been identified in the Office Action as to why one skilled in the art would have been motivated by the teachings or suggestions in Tai for a backlighting system for a transmission type display to arrive at the front illuminating device of claim 1. There also is no reference to Tai being provided or indicated in the Office Action of a reasonable expectation of success for such a modification that is found or indicated in Tai.

It is respectfully submitted that the foregoing remarks distinguishing claim 1 from the cited art also applies to distinguish the front illumination device of claim 34 from the cited art.

It is respectfully submitted that claims 1-17 and 34 are patentable over the cited reference(s) for the foregoing reasons.

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NAKABAYSAHI ET AL.

Claims 1-17 and 34 stand rejected as being unpatentable over Nakabaysahi et al. [USP 6,379,017; "Nakabysahi"] for the reasons provided on page 3 of the above referenced Office Action. Applicants respectfully traverse.

The subject application has a filing date of September 13, 1999 and Nakabayashi has an effective filing date of May 12, 1998, as it is a divisional of an earlier filed application. Thus, the cited reference has a filing date that is not more than one year before the filing date of the subject application.

Also, the subject application is a continuation-in-part (CIP) application and as such, certain of the claims and subject matter of the present invention were not added to the CIP application. As such, these claims and subject matter correspond to the claims and subject matter of U.S.S.N. 09/048,527, having a filing date of March 26, 1998. Therefore, these claims and subject matter are entitled to the benefit of this earlier filing date.

In this regard, claims 1-17 and 34 and the subject matter related thereto were not added to the subject CIP application but rather correspond to claims and subject matter of the earlier filed application. As such, at least claims 1-17 and 34 and the subject matter related thereto are entitled to the benefit of the March 26, 1998 filing date. Thus, a prior art reference having a filing date later than March 26, 1998 and/ or a filing date that is not more than one year before March 26, 1998 is not prior art for these claims.

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As indicated above, Nakabayashi has an effective filing date of May 12, 1998. Thus, Applicants respectfully submit that Nakabayashi is not prior art as to claims 1-17 and 34.

It is respectfully requested therefore that the within rejection of claims 1-17 and 34 be thus withdrawn in view of the foregoing remarks.

BAO ET AL.

Claims 1-17 and 34 stand rejected as being unpatentable over Bao et al. [USP 6,266,108; "Bao"] for the reasons provided on page 3 of the above referenced Office Action. Applicants respectfully traverse.

The subject application has a filing date of September 13, 1999 and Nakabayashi has an effective filing date of May 12, 1998, as it is a divisional of an earlier filed application. Thus, the cited reference has a filing date that is not more than one year before the filing date of the subject application.

The present application is a continuation-in-part (CIP) application and as such, certain of the claims and subject matter of the present invention were not added to the CIP application. As such, these claims and subject matter correspond to the claims and subject matter of U.S.S.N. 09/048,527, having a filing date of March 26, 1998. Therefore, these claims and subject matter are entitled to the benefit of this earlier filing date.

In this regard, claims 1-17 and 34 and the subject matter related thereto were not added to the subject CIP application but rather correspond to claims and subject

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matter of the earlier filed application. As such, at least claims 1-17 and 34 and the subject matter related thereto are entitled to the benefit of the March 26, 1998 filing date. Thus, a prior art reference having a filing date later than March 26, 1998 and/ or a filing date that is not more than one year before March 26, 1998 is not prior art for these claims.

The cited reference, Bao, has an effective filing date of March 24, 1998. Thus, Applicants respectfully submit that Bao is not prior art as to claims 1-17 and 34.

It is respectfully requested therefore that the within rejection of claims 1-17 and 34 be thus withdrawn in view of the foregoing remarks.

It is respectfully submitted that for the foregoing reasons, claims 1-17 and 34 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

OTHER MATTERS

Applicants filed a Search Report Information Disclosure Statement dated December 5, 2002 in the USPTO, which IDS pre-dates the above-referenced Office Action. Accordingly, Applicants respectfully request that the Examiner reflect their consideration of this IDS in the next official communication from the USPTO. Applicants also respectfully request the Examiner to call the undersigned collect and the below number in the event that this IDS has not been received by the Examiner and thus needs to be again submitted by Applicants for the Examiner's consideration.

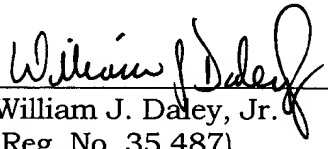
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It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
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Date: March 7, 2003

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